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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/507,062

08/23/2004

Paul Joseph Fagan

CL 1987USPCT

8843

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07/06/2006

E I du Pont de Nemours and Company
Legal - Patents
Wilmington, DE 19898

EXAMINER

ZUCKER, PAUL A

ART UNIT

PAPER NUMBER

1621

DATE MAILED: 07/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/507,062	Applicant(s) FAGAN ET AL.	
	Examiner Paul A. Zucker	Art Unit 1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 8/23/2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/16/05</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: Applicants should amend the first sentence of the specification to refer to all prior application the benefit of which is desired. Appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claim 18 is rejected under 35 U.S.C. 101 because it is drawn to non-statutory matter. The claimed recitation of a process, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claim 5 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 5 recites the limitation "H_o" in line 3. The limitation

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"H_o" has not been defined. The scope of claim 5 is therefore impossible to determine and claim 5 is rendered indefinite. NOTE: The Examiner considers, for the purposes of this rejection, the phrase "the composition of claim 2 used as a fuel to be equivalent to "the use of the composition of claim 2 as a fuel".

2. Claim 18 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 18 is drawn to the use of the composition of Claim 2 as a fuel, etc., but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced. Claim 18 is therefore rendered indefinite.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 2-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Olson et al (Levulinate Esters from Biomass Wastes, Book of Abstracts, 218th ACS National Meeting, New Orleans, Aug 22-26, 1999, CELL-013). Olson discloses (Abstract, lines 3-5) the formation of a mixture of formate and levulinate esters by the acid

catalyzed reaction of cellulosic materials with ethanol or methanol. Its constituents and not its method of formation characterize a composition. Olson therefore anticipates claims 2-18.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
4. Claims 2-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Olson et al (Levulinate Esters from Biomass Wastes, Book of Abstracts, 218th ACS National Meeting, New Orleans, Aug 22-26, 1999, CELL-013) in view of Jungbluth et al (WO 94/21753-A1 109-1994).

Instantly claimed are compositions comprising levulinate and formate esters and their use in gasoline, diesel or biofuel.

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Olson teaches (Abstract, lines 3-5) the formation of a mixture of formate and levulinate esters by the acid catalyzed reaction of cellulosic materials with ethanol or methanol. Its constituents and not its method of formation characterize a composition. Olson further teaches (Abstract, lines 1-4) that levulinates may be used in the production of fuels.

The difference between the fuels taught by Olson and those instantly claimed is that specific percentages of levulinate content are instantly claimed while Olson only generically teaches the use of levulinate esters in fuels.

One of ordinary skill in the art, however, would routinely determine the proper content of levulinate ester to use in the course of optimizing a fuel mixture. One of ordinary skill in the art would have been motivated to do so by Olson's suggestion that levulinate esters can be used to produce fuels. Because of this suggestion, there would also have been a reasonable expectation for success.

Another difference between the teaching of Olson and the instantly claimed invention is that Olson is silent with regard to production of gasoline while such is instantly claimed.

Jungbluth, however, teaches (Abstract, lines 1-3) the use of levulinates in gasoline and diesel fuels. This teaching would have motivated one of ordinary skill in the art to employ, with a reasonable expectation for success, the levulinates of Olson for the production of diesel fuel and gasoline.

Thus the instantly claimed compositions and fuels would have been obvious to one of ordinary skill in the art.

Double Patenting

5. Claims 1-23 of this application conflict with claims 1-23 of Application No. 10/404,322. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 19-21 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 19-21 of copending Application No. 10/768,276. Although the conflicting claims are not identical, they are not patentably distinct from each other because except for the claimed embodiment in 10/768,276 when angelicalactone is used to produce an ester product as in claim 1, the levulinate/formate mixtures produced in the instant application and 10/768,276 are considered by the Examiner to be identical.

Thus one of ordinary skill in the art wishing to produce levulinate/formate based fuels would have been motivated, with a reasonable expectation for success, to use the composition taught by 10/768,276 for that purpose.

Thus the instantly claimed compositions and fuels would have been obvious to one of ordinary skill in the art.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Objections

7. Claim 7 is objected to because of the following informalities: Applicants should employ commas “,” instead of semicolons “;” to separate the recited list of members of the Markush group. Appropriate correction is required.
8. Claim 16 is objected to because of the following informalities: The word “presence” in line 2 is misspelled. Appropriate correction is required.

Conclusion

9. Claims 1-23 are pending. Claims 1-23 are rejected. Claim 7 and 16 are objected to.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul A. Zucker whose telephone number is 571-272-0650. The examiner can normally be reached on Monday-Friday 7:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann R. Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published

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applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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